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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,487	03/01/2004	Richard Konig	HMM-001-1	9504
27833 7590 03/04/2010 TECHNOLOGY, PATENTS AND LICENSING, INC. 2003 South EASTON ROAD SUITE 208 DOYLESTOWN, PA 18901				
EXAMINER				
DURAN, ARTHUR D				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
03/04/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/790,487

**Applicant(s)**

KONIG ET AL.

**Examiner**

Arthur Duran

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/9/09; 10/12/07; 8/1/06; 3/20/06; 9/30/06; 11/1/04; 10/12/04; 4/14/04; 5/11/09; 6/27/08; 1/4/08.

### **DETAILED ACTION**

Claims 1-20 have been examined.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (20020124077).

Claim 1, 3, 5, 6, 9, 11, 13, 20. Hill discloses a method for ad reselling, the method comprising:

receiving a video signal (Fig. 1; [8]);

detecting an advertisement in the video signal using fingerprint data ([4, 31];

claims 17, 34);

replacing the advertisement with a replacement segment ([59-62]); and

receiving payment from a sponsor of the replacement segment ([7, 2, 3]).

Hill does not explicitly disclose that the detected ad can be replaced by the targeted ad.

However, Hill further discloses that all ads have tags/fingerprints ([4, 31]; claims 17, 34). And, Hill further discloses universal/untargeted advertisements and also targeted advertisement ([59-62]). Note that Hill discloses that a broadcast can universally receive the same ads and/or that a broadcast can have different ads placed because of different target audiences or segments. Hence, during the same broadcast, different audiences or segments can receive different targeted ads. Hence

it is obvious that Hill's universal ad can be replaced by Hill's targeted ads. One would be motivated to do this to better send and of interest to the viewers.

Hill further discloses traffic and billing unit ([7, 2, 3]).

Hill further discloses that automatic detection of ads is obvious, old and well known (Background [4]). Hill does not explicitly disclose manual detection of ads. However, Hill discloses automatic detection and this indicates that the now automatic process had been priorly manual. And, the MPEP states that automating a manual activity is obvious (MPEP 2144.04.III). Hence, conversely, it is obvious that if you can automate a manual activity you can make manual an automatic activity. And, the making automatic of a manual activity presupposes the manual activity. Hence, it is obvious that Hill can detect ads automatically or manually. One would be motivated to do this to offer flexibility in how ads are detected ([63, 64]).

Claim 2, 10. Hill discloses the method as recited in claim 1, wherein the fingerprint data is stored in a fingerprint database (claim 17, 34).

Claim 4, 7, 8, 12, 18, 19. Hill discloses the method as recited in claim 3, wherein the manual detection is performed remotely and transmitted using a computer communications network (Fig. 1).

Claim 14. Hill discloses the ad reselling apparatus as recited in claim 13, wherein the ad output unit outputs trigger signals to the ad insertion unit ([59-62]).

Claim 15, 16. Hill discloses the ad reselling apparatus as recited in claim 13, further comprising: a fingerprint receiving unit receiving fingerprint data from a fingerprint database; and a detection unit detecting segments using the fingerprint

data and outputting respective trigger signals to the ad insertion unit ([4, 31]; claims 17, 34 ; [59-62]). Also, in further regards to claim 16, note that Hill's fingerprints correspond to tags or triggers ([31]).

Claim 17. Hill discloses the ad reselling apparatus as recited in claim 13, further comprising: an ad accounting unit transmitting or receiving financial data related to replaced advertisements to a traffic and billing unit ([7, 2, 3]).

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Levy 20030012548 discloses many relevant features for fingerprint, watermarks and ads. Guheen 6536037 and Mikurak 6606744 also disclose fingerprints, advertisements, and ad targeting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
Art Unit 3622

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6/16/2009